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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/967,077	09/28/2001	Travis J. Parry	10005952-1	4921

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

AMINZAY, SHAIMA Q

ART UNIT	PAPER NUMBER
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2684

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/967,077

Applicant(s)

PARRY, TRAVIS J.

Examiner

Shaima Q. Aminzay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, and 5-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Application filed on 8/28/2001.
2. Independent Claims 1, 9, 12, 16, 19, 30 and dependent claims 2-3, 5-8, 10-11, 13-15, 17-18, 20-29 are pending in the case.
3. Claim 4 has been cancelled.
4. The present title of the application is "" (as originally filed).
5. **THIS ACTION IS MADE FINAL.**

Claim Rejections - 35 USC § 103

- ◆ The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- ◆ Claims 1-3, and 5-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black U. S. Publication number 20010055411, and in view of Keagy U. S. Patent number 6069969.

6. Regarding claims 1, 9, 10, 11, 12, 13 and 30, Black teaches an electronic writing instrument (see for example, Figures 1A-1B), comprising: a body (see for example, Figures 1A-1B, the body of the electronic writing instrument); a nib located at an end of the body for applying writing strokes on a surface (see for

example, the electronic writing instrument clearly shows in Figures 1A-1B, and describes the nib function that is located at the end of the body for applying writing strokes on a surface in paragraph [0009], lines 6-7, and [0030], lines 1-11, [0045], lines 4-7); a finger pad on the length of the body on which a fingerprint of a user's finger rests when the user is holding the writing instrument in a writing position (see for example, the writing instrument in Figures 1A-1B clearly shows a finger pad on the length of the body (labeled "fingerprint sensor") which the user's finger rests (see for example, one of the embodiments of Black's invention in Figure 8)); a fingerprint scanner configured to scan the fingerprint when the user's finger is resting on the finger pad and using the electronic writing instrument (see for example, paragraph [0009], lines 3-7; Figure 1A-1B (labeled "scanner"))).

However, Black does not teach a feature in communication with the fingerprint scanner and configured to identify a plurality of fingerprint features of the user's fingerprint scanned by the fingerprint scanner; and a converter in communication with the feature identifier end configured to convert fingerprint features identified by the fingerprint scanner into a private key code.

Keagy teaches a feature in communication with the fingerprint scanner (see for example, Figure 2) and configured to identify a plurality of fingerprint features of the user's fingerprint scanned by the fingerprint scanner (see for example, Figure 2, column 6, lines 31-43, lines 52-56, and column 11, lines 1-5); and a converter in communication with the feature identifier end configured to convert

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fingerprint features identified by the fingerprint scanner into a private key code uniquely identifying the fingerprint (see for example, column 11, lines 1-6, and lines 12-23), and deriving a public key code from the private key code and incorporating the public key code or private key code into an electronic signature (see for example, column 11, lines 1-35 for creating private and public key codes, and further see, column 6, lines 31-43 for creating electronic "signature", Keagy teaches creating public and private key code and further does not limit the procedure (see for example column 11, lines 39-40) to create electronic signature using public key code).

It would have been obvious to one of ordinary skill in the art at the time invention was made to combine Keagy's fingerprint scanner configuration to identify plurality of fingerprint features with Black's identify authentication device to provide an electronic writing instrument with fingerprint scanner "that captures a digital signature (which is the international standard of identification) at the same time that the electronic signature (the written text) is captured, the combined signature being irrefutable" (Black, [0009], lines 1-5), and to provide accurate and high quality fingerprint image for creating private and public key codes which are used for identification and authentication (Keagy, column 2, lines 17-19, column 4, lines 6-7, and column 11, lines 2-5, and lines 18-23).

7. Regarding claims 16, 17, 19, 20, 21, 24, and 25, Black teaches executable computer media for scanning a fingerprint of a writing instrument user to obtain fingerprint data that uniquely identifies the fingerprint (see for example,

paragraph [0009], lines 3-10, "Once the identity of the writer has been authenticated by comparison against a reference print, the signature of the writer irrefutable" (uniquely identifies); and selecting "fingerprint sensor" ([0059], lines 1-2) or scanner with microprocessor that can perform specific instructions depending on the software program (executable) or computer-readable-media [0061], lines 1-13).

Black does not specifically teach identifying a plurality of fingerprint features of the user's scanned fingerprint; and converting the identified fingerprint features into a private key code, and receiving fingerprint data from an electronic writing instrument and creating a public key code using the fingerprint data; and creating an electronic signature using the public key code or private key code fingerprint data.

Keagy teaches identifying a plurality of fingerprint features of the user's scanned fingerprint (see for example, Figure 2, column 6, lines 31-43, lines 52-56, and column 11, lines 1-5), and converting the identified fingerprint features into a private key code (see for example, column 11, lines 1-6, and lines 12-23, using computer program or instructional software), and receiving fingerprint data from an electronic writing instrument and creating a public key code using the fingerprint data (see for example, column 11, lines 1-35 for creating private and public key codes), and creating an electronic signature using the public key code or private key code fingerprint data signature (see for example, column 6, lines 31-43 for creating electronic "signature", and column 11, lines 1-35 for creating

private and public key codes, Keagy teaches creating public and private key code and further does not limit the procedure (see for example column 11, lines 39-40) to create electronic signature).

It would have been obvious to one of ordinary skill in the art at the time invention was made to combine Keagy's fingerprint scanner configuration to identify plurality of fingerprint features with Black's identify authentication device to provide an electronic writing instrument with fingerprint scanner "that captures a digital signature (which is the international standard of identification) at the same time that the electronic signature (the written text) is captured, the combined signature being irrefutable" (Black, [0009], lines 1-5) and includes a computer processor that can be programmed with instructional software that adds to its marketability (see for example, [0009], line 2, and [0045], lines 3-7), and to provide accurate and high quality fingerprint image for creating private and public key codes which are used for identification and authentication (Keagy, column 2, lines 17-19, column 4, lines 6-7, and column 11, lines 2-5, and lines 18-23).

8. Regarding claim 23, Black and Keagy teach claim 19, and further Keagy teaches incorporating the fingerprint data into the electronic signature (see for example, column 6, lines 31-43),
9. Regarding claims 22, 27, 28, and 29, Black and Keagy teach claims 12, 16, 19, and further Keagy teaches private key code derived from the fingerprint data (see for example, column 11, lines 1-23), and), and the private key code includes

at least one digit for each feature identified by the feature identifier (see for example, column 6, lines 22-56; specifically where the fingerprint data is being digitized (lines 31-43) and further where the private key code is generated (column 11, lines 1-6, and lines 12-23)), each digit having a value representing a degree of the fingerprint feature associated with that digit (see for example, column 6, lines 9-56; specifically where the fingerprint data is being digitized, lines 31-43).

10. Regarding claim 18, Black and Keagy teach claim 17, and further Black teaches transmitting the fingerprint data to the computing device over a wireless link (see for example, paragraph [0009], lines 14-15, [0011], lines 1-11, and some of the wireless applications such as paragraph [0022], lines 4-7, and [0025], lines 10-16).
11. Regarding claim 2, Black and Keagy teach claim 1, and further Black teaches the writing instrument comprising a ball point pen cartridge (see for example, paragraph [0048], lines 1-4, 14-17 one of the embodiments, and another embodiment such as in paragraph [0047], lines 6-8, lines 16-17, and [0049], lines 3-6), wherein the nib further comprises a ball on an end of the ball point pen cartridge (see for example, Figure 7 (the nib), and paragraph [0047], lines 4-8).
12. Regarding claims 3, 7, 8, and 26, Black and Keagy teach claims 1, 9, and further Keagy teaches the converter is configured to convert fingerprint features identified by the fingerprint scanner into a private key code (see for example, column 11, lines 1-6, and lines 12-23), wherein the private key code includes at

least one digit for each feature identified by the feature identifier (see for example, column 6, lines 22-56; specifically where the fingerprint data is being digitized (lines 31-43) and further where the private key code is generated (column 11, lines 1-6, and lines 12-23)), each digit having a value representing a degree of the fingerprint feature associated with that digit (see for example, column 6, lines 9-56; specifically where the fingerprint data is being digitized, lines 31-43), and the private key code is used to create at least a part of an electronic signature identifier (see for example, column 6, lines 22-56; specifically where the fingerprint data is being digitized (lines 31-43) and further where the digitized data is used for private key code and generation of electronic signature (see for example, column 6, lines 52-56, and column 11, lines 1-6, and lines 12-23)).

13. Regarding claim 5, Black and Keagy teach claim 1, and further Black teaches an output port configured to output data from the writing instrument to a computing device (see for example, paragraph [0010], lines 5-9).
14. Regarding claim 6, Black and Keagy teach claim 1, and further Black teaches a wireless transmitter configured to transmit data from the writing instrument to a wireless receiver located remote from the writing instrument (see for example, paragraph [0009], lines 14-15, [0011], lines 1-11, and some of the wireless applications such as paragraph [0022], lines 4-7, and [0025], lines 10-16).
15. Regarding claims 14, and 15, Black and Keagy teach claim 12, and further Black teaches wherein the affixing the electronic signature to an electronic

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document further comprises scanning a document to create a corresponding electronic document and affixing the electronic signature to the corresponding electronic document (see for example, paragraph [0002], lines 1-3, the electronic signature affix to another document such as identification card; and further limitations are explained in paragraphs [0011], lines 7-11, [0012] – [0016]).

Response to Arguments

16. Applicant's arguments filed 9/28/2001 have been fully considered but they are not persuasive.

Applicant argues (on page 13, second paragraph lines 1 and 2, claims 16-18, and 5th paragraph, claims 19-25) that Black does not teach "one or more computer readable media having instructions that when executed perform a number of steps". Examiner respectfully disagrees.

The claims are directed to an electronic writing instrument with a microprocessor or computer memory for data manipulation including instructions or steps to perform specific activities, the only possible way to perform instructions electronically is to execute one or more computer readable media. Black clearly states the electronic writing instrument includes a microprocessor (CPU, RAM, ROM, etc.) with memory (see for example, paragraph [0009], lines 3-10, [0056], lines 27-32 (this activity will never take place without instruction through computer-electronic media), and further selecting "fingerprint sensor" ([0059], lines 1-2) or scanner with microprocessor that can perform specific instructions depending on the software program (executable) or computer-readable-media, [0061], and lines 1-13).

Conclusion

17. THIS ACTION IS MADE FINAL.

18. Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

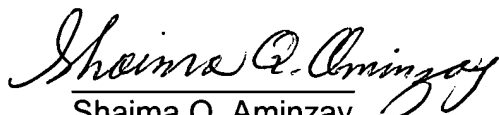
19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 form.

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Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shaima Q. Aminzay whose telephone number is 703-305-8723. The examiner can normally be reached on 7:00 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 703-308-7745. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 2600's customer service telephone number is 703-305-3900.


Shaima Q. Aminzay
(Examiner)

April 26, 2004


NAY MAUNG
SUPERVISORY PATENT EXAMINER

Nay Maung
(SPE)
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